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REMARKS

I. Status of the Application.

Claims 1-23 of the Application were pending as of the date of the Office Action. In the Office Action, the Examiner:

- (a) Objected to the information disclosure statement filed on August 13, 2003 for failing to include copies of the foreign patent documents;
- (b) Provisionally rejected claims 1, 4, 8, 9, 12, 16, and 17 under the judicially created doctrine of obviousness-type double patenting;
- (c) Rejected claims 1-17 under 35 U.S.C. §103(a) as being allegedly obvious over U.S. Patent No. 6,837,601 to Tatsukawa ("Tatsukawa") in view of U.S. Patent No. 6,190,029 to Taniuchi et al. ("Taniuchi"); and
- (d) Rejected claims 18-23 under 35 U.S.C. §102(e) as being allegedly anticipated by U.S. Publication No. 2003/0174509 to Futami ("Futami");

In this response, Applicant submits the missing references, makes a terminal disclaimer, amends claims 1, 17, 18, and 21, cancels claims 22 and 23, and adds claim 24. Applicant respectfully submits that the foregoing amendments and following remarks incorporated herein overcome the Examiner's rejections of and objections to the Application.

II. Applicant's Amendments Do Not Constitute New Matter.

Applicant respectfully submits that the amendments to the claims do not add new matter to the Application. For example, amended claims 1 are supported by pages 5-12 of the originally filed Application. The amendment to claim 17 merely corrects a typographical error. Moreover,

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amended claims 18 and 21 are supported by pages 14-19 of the originally filed Application. For the above-listed reasons, Applicant respectfully submits that all the amendments are supported by the specification, as originally filed, and do not constitute new matter. Accordingly, Applicant respectfully requests acceptance of these amendments.

III. The Objections To The Information Disclosure Statement Should Be Withdrawn.

The Examiner objected to the information disclosure statement submitted on August 13, 2003 under 37 C.F.R. §1.98(a)(2) for not enclosing copies of foreign patent documents DP 0 661 495 A1 and P2001-118407 (JP). Applicant encloses a copy of the August 13, 2003 information disclosure statement with the missing foreign patent documents EP 0 661 495 A1 and P2001-118407A (JP). For these reasons, Applicant respectfully submits that the Examiner's objection to the information disclosure statement has been overcome and respectfully request that the objection be withdrawn.

IV. The Nonstatutory Double Patenting Rejection Of Claims 1, 4, 8, 9, 12, 16, And 17 Should Be Withdrawn.

Applicant submits herewith a terminal disclaimer to obviate the rejection of claims 1, 4, 8, 9, 12, 16, and 17 under the judicially created doctrine of obviousness-type double patenting. Applicant respectfully requests that the \$130.00 fee for the terminal disclaimer be withdrawn from client's deposit account number 09-0007. For this reason, Applicant respectfully requests that the rejections of claims 1, 4, 8, 9, 12, 16, and 17 under the judicially created doctrine of obviousness-type double patenting be withdrawn.

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V. **The Rejections Of Claims 1-17 Under 35 U.S.C. §103(a) As Being Obvious Over Tatsukawa In View Of Taniuchi Should Be Withdrawn.**

Applicant respectfully submits that the rejection of claims 1-17 should be withdrawn because neither Tatsukawa nor Taniuchi disclose, teach or suggest all the limitations of claims 1-17. Three criteria must be met to establish a *prima facia* case of obviousness: (i) there must be some suggestion or motivation to combine the teachings of two or more prior art references; (ii) there must be a reasonable expectation of success; and (iii) "all of the claim limitations must be taught or suggested by the prior art." MPEP §§ 2143 and 2143.03 (citing *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974)). "If an independent claim is not obvious under 35 U.S.C. §103, then any claim depending therefrom is not obvious." MPEP 2143.03 (citing *In re Fine*, 837 F.2d 1382, 1385 (C.C.P.A. 1970)).

Taniuchi discloses, teaches and suggests a headlamp that utilizes a light source 2, a lens 5, a reflecting mirror 4 with a first reflecting surface 41 and a second reflecting surface 42, and a hood 3 with a moving member 32 that opens or closes a cut portion 31a to create a high beam and low beam light pattern. (Col 2, ll. 61-67; Col. 3, ll. 1-62). Tatsukawa discloses, teaches and suggests a lighting system 10 that provides a bending light unit 20 that turns on when the vehicle turns to the left. (Col. 4, ll. 49-55). The lighting unit 20 comprises a light source bulb 22, a reflector 24, a moveable shade 26, a shade driving device 28, and a fixing shade 30. (Col. 4, ll. 62-65). Depending on the speed of the vehicle, the shade 26 can be either moved forward or backward to illuminate different regions of the same reflector to provide a large light distribution pattern having an almost uniform luminous intensity (Pa1) or a small light distribution pattern having a comparatively high luminous intensity (Pa2). (Col. 5, ll. 24-67; Col. 6, ll. 1-40).

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Applicant respectfully submits that neither Taniuchi nor Tatsukawa discuss or make mention of a non-reflective surface being positioned in between a first reflective surface and a second reflective surface as claimed in claims 1-16. The Examiner contends that a horizontal portion of reflecting surface 41 of Taniuchi is a non-reflecting surface that is disposed between the first reflecting surface and second reflecting surface. Applicant respectfully submits that nothing in Taniuchi supports this conclusion. Rather, Taniuchi discloses, teaches and suggests that this horizontal portion is part of reflecting surface 41 that reflects light through the lens. Taniuchi states that "first reflecting surface 41 is formed on the reflecting mirror 4 . . . in the shape such as to generate the low beam distribution S as shown in Figure 5." (Col. 3, ll. 29-32). Taniuchi provides further that in one embodiment, "first reflecting surface 41 is formed in a paraboloid shape, and the light source 2 is disposed properly in front of the focal point of the paraboloid." (Col. 3, ll. 34-37). The disclosure of Taniuchi does not describe this horizontal section as being anything but part of reflecting surface 41 that reflects light through the lens. Nor do the figures of Taniuchi show what happens to any light ray that strikes the horizontal surface to suggest that it would not reflect light through the lens. Accordingly, Applicant respectfully submits that Taniuchi does not disclose, teach or suggest a "non-reflective surface disposed between the first reflective surface and the second reflective surface," as claimed in amended claims 1 and 17 and original claim 9.

Even if the Examiner is correct in the assumption that the horizontal surface in Taniuchi can be considered the claimed non-reflective surface, Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of obviousness because no motivation or

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suggestion exists to replace the reflector of the bending light of Tatsukawa with the Taniuchi reflector. To establish *prima facie* obviousness, "there must be some suggestion or motivation, in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings." MPEP §2143. The suggestion to make the claimed combination *must come from the prior art and not from the applicant's disclosure or from the level of skill of the art.* *Id.* (citing *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991)); MPEP §2143.01 (citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999)). To be motivated to combine the references, one skilled in the art, without the teaching of the Applicant's disclosure, would have to look at Taniuchi and Tatsukawa and determine that some benefit would result from including the horizontal surface of the Taniuchi reflector with the reflector of Tatsukawa or replacing the Tatsukawa reflector with the Taniuchi reflector.

Applicant respectfully submits that nothing in Taniuchi discusses or suggests that its reflector with the horizontal surface provides any advantages over other reflectors known in the prior art. As already explained, Taniuchi does not discuss, refer to, or even mention anything regarding the horizontal surface that the Examiner alleges is the claimed non-reflective surface. Applicant respectfully submits that one of ordinary skill would have no reason to combine Tatsukawa with Taniuchi because without a minimal level of teaching or discussion of the horizontal surface in Taniuchi, one of ordinary skill in the art would not realize any significance of using the reflector with a horizontal surface. In other words, it could not be possible for one of ordinary skill to find any suggestion or motivation from the references to replace the reflector

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of Tatsukawa with the reflector of Taniuchi, because Taniuchi itself does not discuss the horizontal surface of the Taniuchi reflector

Despite the total lack of discussion of the horizontal surface, or any suggestion that the Taniuchi reflector would somehow provide an advantage over the Tatsukawa reflector, the Examiner states that the motivation to combine the reference is to "modify the reflector structure of Tatsukawa with the non-reflective surface as taught by Taniuchi for purposes of providing an advantageous way of aligning reflector structure to obtain a desired low/high beam." (January 18, 2005, Office Action, pp. 4-5). It is respectfully submitted that Taniuchi cannot provide such a motivation because Taniuchi does not discuss, refer to, or even mention the horizontal surface, let alone suggest that it would provide such an alignment advantage. Thus, Applicant respectfully submits that one of ordinary skill in the art could not conclude that the alleged non-reflective surface of Taniuchi would provide "an advantageous way of aligning reflector structure to obtain a desired low/high beam", because nothing in the references supports or would suggest such a conclusion.

Moreover, Applicant respectfully submits that the Examiner's stated motivation of combining Taniuchi with Tatsukawa cannot be correct, because the resulting combination would not result in a low/high beam lamp assembly. Tatsukawa does not disclose, teach or suggest a low/high beam lamp but rather, discloses, teaches and suggests a bending light that utilizes a movable shield to illuminate different regions of the same reflector at separate times to provide a large light distribution pattern having an almost uniform luminous intensity (Pa1) or a small light distribution pattern having a comparatively high luminous intensity (Pa2). (Col. 5, ll. 24-67; Col.

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6, ll. 1-40). Accordingly, Applicant respectfully submits that the Examiner's stated motivation of "providing an advantageous way of aligning reflector structure to obtain a desired low/high beam" cannot be correct because the combination of Tatsukawa with Taniuchi would not result in a high/low beam light assembly but rather, a bending light that utilizes the Taniuchi reflector.

To establish a *prima facie* case of obviousness, some motivation or suggestion, other than the teaching of Applicant's disclosure, would have to exist that would cause one of ordinary skill in the art to believe that there would be some benefit in replacing the Tatsukawa reflector with the Taniuchi reflector to create this bending light. As already explained, nothing in Taniuchi discusses, refers to or even mentions the horizontal surface. Thus, Applicant respectfully submits that one skilled in the art would not have any motivation or suggestion to combine the two references, because one skilled in the art would draw nothing from the references that would suggest or motivate him/her to want to replace the reflector already used in Tatsukawa with the reflector used in Taniuchi.

Accordingly, Applicant respectfully submits that neither Tatsukawa nor Taniuchi disclose, teach or suggest a lamp assembly comprising a reflector with "a non-reflective surface disposed in between the first reflective surface and the second reflective surface", as claimed in claims 1, 9 and 17. Moreover, even if Taniuchi did disclose, teach or suggest the claimed non-reflective surface, Applicant respectfully submits that no motivation or suggestion exists to combine the references to come up with the claimed inventions of claims 1, 9, and 17. For these reasons, Applicant respectfully submits that the rejections to claims 1, 9 and 17 and claims 2-8

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and 10-16, which depend from these independent claims, under 35 U.S.C. §103(a) should be withdrawn.

VI. The Rejections Of Claims 18-23 Under 35 U.S.C. §102(e) As Being Anticipated By Futami Should Be Withdrawn.

Applicant respectfully submits that the rejection of these claims should be withdrawn because Applicant has amended claims 18 and 21 to distinguish over Futami. Applicant respectfully submits that Futami does not disclose all the limitations of amended claims 21-32. A rejection under section 102(e) can be overcome by amending the claims to patentably distinguish over the prior art. MPEP §706.02(b).

Applicant respectfully submits that claims 18-21 and 25 are patentably distinguished over Futami because Futami does not disclose all the limitations of independent claims 18 and 21. For example, Futami does not disclose "a non-reflective surface disposed between a first reflective surface and a second reflective surface", as claimed in claims 18 and 21. Moreover, Futami does not disclose "a shield between a first position and a second position, such that when the shield is in the first position light shines on the first reflective surface and the non-reflective surface and is substantially blocked from striking the second reflective surface and when the light shield is in the second position light shines on the second reflective surface and the non-reflective surface and is substantially blocked from striking the first reflective surface", as claimed in claim 18. Nor does Futami disclose "a shield movable between a first position that allows light from the light source to strike the first reflective surface to form a first light beam, and a second position that allows light from the light source to strike the first and the second

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reflective surfaces to form a second light beam," as claimed in claim 21. For these reasons, Applicant respectfully submits that the rejections to claims 18 and 21 and claims 19-20 and 25, which depend from these independent claims, under 35 U.S.C. §102(e) should be withdrawn.

VII. Applicant Petitions for an Extension of Time.

Applicant hereby petitions for an extension of time of two (2) months, under 37 C.F.R. § 1.136(a), thereby extending the deadline for response to Wednesday, September 28, 2005. Applicant authorize payment for this extension in the amount of \$450.00 to be charged to deposit account 09-0007. When doing so, please reference the above-referenced client's docket number of P00769-US-01.

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CONCLUSION

For all of the foregoing reasons, it is respectfully submitted that claims 1-21 and 24 are allowable claims. Allowance of this Application is therefore respectfully requested. In the event Applicant has inadvertently overlooked the need for payment of any fees, Applicant conditionally petitions therefore, and authorize any deficiency to be charged to deposit account 09-0007. When doing so, please reference the above-listed docket number.

Respectfully submitted,

ICE MILLER

A handwritten signature in black ink, appearing to read "Alex D. Forman".

Alexander D. Forman, 51,691

ICE MILLER

One American Square, Box 82001

Indianapolis, IN 46282-0200

Telephone: (317) 236-5826

Facsimile: (317) 592-5433

Date: 9/16/05

ADF

Enclosures: Terminal Disclaimer

Check number 8597 in the amount of \$580.00

Statement of Ownership under 37 CFR 3.73(b)

Copy of Information Disclosure Statement

Copy of EP 0 661 495 A1

Copy of P2001-118407A(JP)